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In re Application of:
ROGERS, David, M., et al. : DECISION ON PETITION UNDER
U.S. Application No.: 10/567,174 : 37 CFR 1.47(a)
PCT No.: PCT/US2005/019699 :
International Filing Date: 03 June 2005 :
Priority Date: 03 June 2004 :
Attorney's Docket No.: 61459(49366) :
For: OVERSPEED LIMITER FOR :
TURBOSHAFT ENGINES :
:

This decision is issued in response to applicants' "Petition Under 37 CFR 1.497(b)(1) and 1.47(a)" filed 28 September 2006. Applicants have paid the required petition fee.

BACKGROUND

On 03 June 2005, applicants filed international application PCT/US2005/019699. The international application claimed a priority date of 03 June 2004 and it designated the United States. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 03 December 2006.

On 03 February 2006, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 28 September, applicants filed the petition considered herein. The petition requests acceptance of the application without the signature of co-inventor David M. ROGERS, whom applicants assert has refused to execute the declaration.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the nonsigning inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the nonsigning inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants here have submitted the required petition fee, and the petition expressly states the last known address of the nonsigning inventor. Items (1) and (2) are therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, the declaration materials filed by applicants here include one copy of "Page 1 of 4," "Page 2 of 4," and "Page 3 of 4," accompanied by two different copies of the signature page ("Page 4 of 4"). One signature page is executed by one of the named inventors, the other is executed by the two other cooperating inventors. This five-page declaration submission appears to be a compilation of two copies of a four-page declaration, and as such is not acceptable under 37 CFR 1.497 (See MPEP § 201.03(II)(B): "Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration.") Applicants must submit complete copies of the declarations executed by each of the signing inventors (and containing an unsigned signature block for the non-signing inventor). Until the required declarations are submitted, item (3) is not satisfied.

Regarding item (4), MPEP section 409.03(d) states that "[a] copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney." The MPEP also states the following:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Here, applicants have provided a statement from David J. Silvia, with supporting documents, providing a firsthand showing that the non-signing inventor has been provided (via Certified Mail) with a request for signature and a copy of the application papers, that the, after additional email correspondence, the inventor has failed to provide the requested executed declaration. These materials provide an acceptable showing that the non-signing inventor has refused to execute the declaration. Item (4) is therefore satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)"

and must include the materials required to satisfy item (3) of a grantable petition, as discussed above. No additional petition fee is required.

Failure to file a proper response will result in abandonment of the application.
Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT,
Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria,
Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT
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